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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,557	04/14/2004	Nathan Polsky	POLSKY6	4811
1444	7590	09/07/2006	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,557

Applicant(s)

POLSKY, NATHAN

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 17, 20-21, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is not clear because a second transparent sheet is disposed separately from a first sheet and adjacent to a first surface of the same second transparent sheet. This cannot be (see “first transparent sheet and adjacent to”...), thus the structure is not clear. Claims 17 and 20 have similar issues “...and adjacent to...”, where the structure is not clear.

To claims 21 and 27, that a transparent ink layer is directly printed onto a transparent sheet, it is not clear if this transparent sheet is an additional sheet, or the two transparent sheets mentioned prior to, thus the overall structure is unclear. If it is an additional layer in addition, the Examiner suggests using further comprising language.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-8, 10-12, 17-18, 20, 22-23, 25, and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,270,087 to Polsky.

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Polksy teaches a workpiece as claimed per instant claim 1 comprising: transparent substrate, colored sheet (colored ink layer equivalency), and removable scratch opaque layer in the same order as claimed (see patented claims 1-2, and FIGS. 1-5).

Regarding instant claims 8, 11, 20, and 22, Polsky teaches the same structure in FIG. 5 and associated text in this order: 16, opaque scratch coat (same material so capability is met (can be removed with fingers partially))/18, color transparent sheet in one or more layers (3:10-15, both first and second transparent and solid colored sheets)./14 clear, transparent plastic sheet (instant claim 20). Further to capability of being able to be scratched with a finger, is not germane since it has been held that an element that is “being able to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Regarding instant claims 17-18, 25, and 29, Polsky teaches the same structure in FIG. 1 and associated text in this order: 16, opaque scratch coat/14, clear, transparent plastic sheet/18, color transparent sheet in one or more layers (3:10-15, instant claim 25, transparent colored sheet).

Regarding instant claim 2, see patented claim 5 and 16, FIG. 1 and associated text.

Regarding instant claim 3, see patented claim 7.

To instant claims 4 and 10, see patented claim 3 and 2:43.

To instant claim 6, see patented claim 8.

To instant claims 7, 12, 23, 30 see patented claims 4 and 8-12 (product) and 3:10-48.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 13, 19, 24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,270,087 to Polsky in view of USPN 3,815,263 to Oberwager.

Polsky essentially teaches the claimed invention.

Polsky does not teach a kit (instant claims 5, 13, 19, 24, and 31).

Oberwager teaches a kit for stained glass containing elements (scissors, sheets) used for assembly of stained glass articles (do-it-yourself) see 1:5-10, 2:5-30.

It would have been obvious to one having ordinary skill in the art to have modified Polsky to include any construction materials of Polsky in a kit for assembly purposes as Oberwager teaches (1:5-10, 2:5-30).

6. Claims 9, 21, and 26- 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,270,087 to Polsky in view of USPN 2,762,153 to Knode.

Polsky essentially teaches the claimed invention above.

Regarding instant claims 9, 26, and 28, Polsky teaches a rigid substrate (2:35), but Polsky does not teach a cellophane sheet used for the second or first transparent sheet.

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Knode teaches a clear transparent sheet and a transparent colored cellophane sheet used in a transparency laminate for visualizing designs throughout the sheet to illustrate depth, or shading for stained glass applications (1:15-25, 1:60-70, 2:10-50, 3:5-15).

It would have been obvious to one having ordinary skill in the art to have modified Polsky to substitute a transparent sheet for a cellophane sheet because Knode teaches it provides depth, or shading while still being able to see the designs for stained glass applications (1:15-25, 1:60-70, 2:10-50, 3:5-15 of Knode).

To instant claims 21 and 27, Polsky teaches opaque 16/transparent 14/18 color transparent printing ink in one or more layers (3:5-15) in Fig. 1 and associated text (serving as a transparent ink layer directly printed on a transparent substrate 14 (3:22-36)).

If another transparent sheet is required under the ink layer, Knode teaches designs on a clear transparent/colored transparent sheet which may be placed over glass (3:5-15) or the glass could be substituted for the clear plastic transparent layer (1:60-65) also where the transparencies are used to provide art and creative assemblies (1:15-40) providing depth, or shading effects while still being able to see the designs for stained glass applications.

It would have been obvious to one having ordinary skill in the art to have modified the laminate of Polsky to further include ink layers and transparent sheets because Polsky teaches several transparent ink layers may be applied to transparent substrates and Knode teaches further transparent clear and colored sheets as substrates for designs add depth, shading effects and creative assemblies for stained glass applications (1:15-45, 1:60-70, 2:10-50, 3:5-15 of Knode).

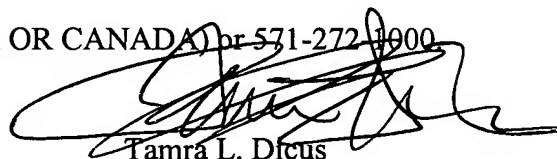
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

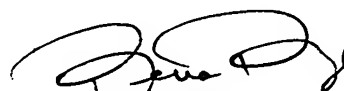
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus
Examiner
Art Unit 1774

August 29, 2006



RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 9/1/06